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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,214	01/24/2002	Mark A. Howard	31515-CON1	3318

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HOVEY WILLIAMS TIMMONS & COLLINS
2405 GRAND BLVD., SUITE 400
KANSAS CITY, MO 64108

EXAMINER
WARE, DEBORAH K

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
10/057,214	Howard et al.
Examiner	**Art Unit**
Deborah Ware	1651

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 21, 2003* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8 and 13* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-8 and 13* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims 1-8 and 13 are presented for reconsideration on the merits.

Applicants are requested to please update the instantly filed specification at page 1, line 5, to indicate the present status of the parent case application serial no. 09/841,552, filed April 23, 2001, which is a continuation of this application and has now issued as U.S. Patent No. 6,552,171.

1. Applicant's election without traverse of claims 1-8 and 13 in Paper No. 8 is acknowledged. Claims 9-12 and 14 are canceled by the amendment filed with the election of March 21, 2003. Furthermore, the extension of 2 months time filed March 21, 2003, with the amendment is acknowledged.

2. Claims 1-8 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claims 1-8 and 13 are rendered vague and indefinite for the **new** recitation of "deactivating protease enzymes" in line 5 of claim 1, wherein the phrase lacks antecedent basis and it is suggested to insert --said-- before "protease" which occurs within the phrase. The dependent claims 2-8 and 13 are rejected for this reason as well because they depend from claim 1 or another dependent claim which is dependent upon claim 1.

4. Claims 3, 5 and 7-8 are further rendered vague and indefinite for the recitation of the step without indicating whether or not these are further additional steps or part of the steps which are recited in claims, 1, 2, or 7. Thus, it is suggested to insert --further-- at line 1 of each of

claims 3, 5 and 7-8. Also claim 7 is additionally rendered vague and indefinite for the recitation of the term "profiles" and "profile" at lines 3 and 4 of claim 7. Thus, it is further suggested to change "weight profiles" to --weights-- at line 3 and delete "profile" at line 4, because the term is superfluous and redundant to its perceived meaning in the claim. It is suggested to simply refer to the different molecular weights and a higher molecular weight, respectively in the claim 7.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 and 6-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-9 of U.S. Patent No. 6,552,171 (A) in view of Branner-Jorgensen (B). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claims are drawn to a method of hydrolyzing defatted jojoba meal comprising, hydrolyzing an aqueous dispersion, adding an acid to an agitated dispersion to lower pH, and forming a mixture and deactivating protease enzymes added thereto during the hydrolyzing step.

The US Patent No. '171, noted above, teaches a product by process wherein the process involves hydrolyzing an aqueous dispersion of jojoba meal using proteases and acid as well as addition of an acid and protease enzyme (see claim 4 of '171).

Branner-Jorgansen teaches deactivating protease enzymes, see col. 2, lines 15-25.

Claims differ from US Pat No. '171 in that the deactivating step is not disclosed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was filed to combine the teachings of the cited references to provide a method of hydrolyzing jojoba, which contains proteins, or any material containing proteins wherein the method includes a deactivation of the protease enzyme(s) step. Branner-Jorgansen clearly teaches that such deactivation steps are well known and the use of heat is a conventional technique in the art for deactivating proteases. The whole claimed invention is essentially encompassed by the teachings of the cited US Patent No. '171 with the exception of deactivating the enzymes not being claimed in the claims of US Patent No. '171, however, the reference does

disclose the technique. Thus, given that Branner-Jorgansen teaches that heat is conventional for deactivating enzymes in hydrolyses processes, it is clear that one of skill would have been motivated to combine the two cited references to obtain a method of hydrolyzing defatted jojoba meal comprising the instant claims' steps as set forth above. None of the steps are unknown to those of ordinary skill in the art. Each of the claimed features, such as lowering pH with acid, obtaining fractions having different molecular weights, adding proteases and deactivating them with heat are clearly disclosed and claimed by the cited patented claimed subject matter and cited secondary disclosure. In the absence of sufficient evidence to the contrary the claims are rendered prima facie obvious over the cited prior art.

Claims 1-3 and 6-7 fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected. However, claims 4-5, 8 and 13 are free of the cited prior art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is (703) 308-4245. The examiner can normally be reached on Mondays to Fridays from 9:30AM to 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware

Art Unit 1651

May 29, 2003